

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 15, 1999

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Allied Companies, Inc.

Serial No. 74/304,743

Robert C. Collins of Barnes, Kisselle, Raisch, Choate,
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107 (Tom Lamone, Managing Attorney)

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The Allied Companies, Inc. has appealed the refusal of
the Trademark Examining Attorney to register the mark THE
ALLIED COMPANIES and design (COMPANIES disclaimed), as

Ser. No. 74/304,743

shown below, for the services of "administering employee benefit plans and retirement plans."¹

The lining shown in the drawing is a feature of the mark and is not intended to indicate color.

Registration has been refused on the ground that applicant's mark, as used in connection with its identified services, so resembles the mark ALLIED INSURANCE COMPANY, with the words "insurance company" disclaimed, originally registered by Allied Insurance Company and now owned by Cygna Company for underwriting insurance services,² and the following four marks, all owned by Allied National, Inc., as to be likely to cause confusion or mistake or to deceive:

with the words
"employers association"
disclaimed, for group
health insurance
administration services³

¹ Application Serial No. 74/304,743, filed August 17, 1992, and asserting first use and first use in commerce in January 1985.

² Registration No. 982,111, issued April 9, 1974; Section 8 affidavit accepted; Section 15 affidavit received; renewed.

³ Registration No. 1,979,087, issued June 11, 1996.

with the words "group
insurance trust"
disclaimed, for
"administration of group
health insurance"⁴

with the words
"employees association"
disclaimed, for group
health insurance
administration services⁵

with the word
"administrators"
disclaimed, for
administration of group
health insurance⁶

Both applicant and the Examining Attorney filed
briefs, and applicant filed a reply brief. An oral hearing
was not requested.

We affirm the refusal on the basis of all five cited
registrations.

As a preliminary point, we note that with its appeal
brief applicant submitted as an exhibit (I) portions of the
files of one of the cited registrations, No. 1,958,186, and
stated that because the Examining Attorney had access to
Patent and Trademark Office records, he could take judicial
notice of the contents of the rest of the registration

⁴ Registration No. 1,959,495, issued March 5, 1996.

⁵ Registration No. 1,970,702, issued April 30, 1996.

⁶ Registration No. 1,958,186, issued February 27 1996.

files. Applicant also submitted with its brief an exhibit (H) with information regarding what it asserted to be third-party registrations. The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office; further, the submission of a list of registrations is insufficient to make them of record. See **In re Duofold Inc.**, 184 USPQ 638 (TTAB 1974). Moreover, Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal. The exhibits submitted by applicant with its brief, which were not previously made of record, are clearly untimely. Because the Examining Attorney has not discussed these exhibits in his brief, and therefore cannot be said to have stipulated them into the record, they have not been considered.

In any determination of likelihood of confusion, two key factors are the similarity of the marks and the similarity of the goods or services. Turning first to the services, applicant's services are identified as "administering employee benefit plans and retirement plans," while the services of the registration for ALLIED INSURANCE COMPANY are identified as "underwriting insurance" and the services in the four registrations owned by Allied National are essentially group health

Ser. No. 74/304,743

administration services. Although applicant's services are not identical to either of the cited registrant's services, it is well established that

it is not necessary that the goods [or services] of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods [or services] of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods [or services] are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.

In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

In this case, the relationship between applicant's and the registrant's services is made manifest by the fact that applicant itself offers such services under the same mark. The brochure submitted with applicant's application, shows that applicant uses its applied-for mark THE ALLIED COMPANIES and design for, inter alia, property and casualty insurance services and services for all areas of group benefits, including medical plans, dental insurance and a prescription drug program. This brochure demonstrates that a single source may make available the three types of

services identified in the cited registrations and applicant's application, and may offer them under a single mark.

Further, although applicant asserts that its services of "administering employee benefit plans and retirement plans" are dissimilar from the "administering group health insurance" services of Allied National, applicant's brochure indicates that employee group benefits would include health insurance:

In addition to a paycheck, more and more employees are attuned to the need and value of group benefits as part of their total compensation package....

Allied Group Insurance offers complete services in all areas of group benefits:

- Medical Plans
 - Traditional
 - Health Maintenance Organizations (HMO's)
 - Preferred Provider Organizations (PPO's)

Thus, applicant's "administering employee benefit plans" would appear to encompass Allied National's administration of group health insurance.

Applicant has attempted to distinguish its services from those of the cited registrations by relying on assertions about the registrants' services made by Allied

Ser. No. 74/304,743

National during the prosecution of one of its applications, and in a consent given by the owner of the ALLIED INSURANCE COMPANY registration to the registration of Allied National's marks. However, the registration file which assertedly contains these statements and consent is not part of the record. As noted previously, applicant's submission of these papers was untimely, and therefore has not been considered. Accordingly, there is no evidentiary support for applicant's assertions.

Moreover, any evidence regarding the actual services rendered by the owners of the cited registration would not serve to limit the scope of the services identified in their registrations. The question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in the cited registration, rather than what the evidence shows the goods and/or services to be. See **Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA**, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); **In re Simulations Publications, Inc.**, 521 F.2d 797, 187 USPQ 147 (CCPA 1975); **In re Allen Electric and Equipment Company**, 458 F.2d 1404, 173 USPQ 689 (CCPA 1972); **In re William Hodges & Co., Inc.**, 190 USPQ 47 (TTAB 1976).

Applicant's services of administering employee benefit plans and retirement plans would appear to be directed to the same class of consumers as Allied National's services of administering group health insurance, namely businesses. The underwriting insurance services identified in the registration for ALLIED INSURANCE COMPANY is not limited as to channels of trade, and we see no reason why that registrant's services could not be offered to the same people to whom applicant's services are directed. Moreover, although the Allied National services and applicant's services may be directly offered to and purchased by companies in connection with their employee benefit plans or group health insurance, the ultimate beneficiaries of the services are the employees who work for those companies. Thus, ordinary consumers, and not only sophisticated purchasers, are likely to be exposed to applicant's and the registered marks.

This brings us to a consideration of the marks. Applicant has made a very detailed analysis of its mark in an attempt to contradict the Examining Attorney's conclusion that ALLIED is not the dominant part of its mark. We will not discuss these arguments in detail, but will say that we find many of statements to be farfetched, and the overall argument unpersuasive. Clearly, the design

of an "A" is a large and noticeable part of applicant's mark. However, it is the word portion that is more likely to make an impression on consumers, because it is by the words that they will refer to and remember the mark. See **In re Appetito Provisions Co.**, 3 USPQ2d 1553 (TTAB 1987). And, notwithstanding applicant's arguments about ALLIED being subordinated because it is the middle of the three words THE ALLIED COMPANIES, and that COMPANIES is dominant because it appears alone and has a line below it, we find that the word ALLIED is the dominant part of the mark. The word THE, in general, has little significance because it is omnipresent. In this regard, we take judicial notice that indexes and directories ignore the word "the" for purposes of alphabetizing entries. The word COMPANIES, too, has little origin-indicating significance since it is a common term to describe a business. Applicant apparently recognized this fact because, as part of its initial application papers, it disclaimed exclusive rights to use this word. Not only is the word ALLIED the strongest source-indicating feature of THE ALLIED COMPANIES, but this word is emphasized by the large letter "A" design.

Similarly, ALLIED is the dominant element of each of the cited registrations. In ALLIED INSURANCE COMPANY the word ALLIED is the only source-indicating word, INSURANCE

COMPANY being descriptive for the service of underwriting insurance, as the registrant's disclaimer of these words acknowledges. In the four registrations owned by Allied National, ALLIED is clearly the dominant term. Not only is it shown in a larger size than the other words in those marks, but the other words merely describe the services, as the disclaimers for those words indicate. We acknowledge applicant's statement that the public is not aware of disclaimers, but they are aware of the descriptive significance of words. The public would clearly view the word ALLIED in each of the cited marks as indicating the source of the services; the remaining elements would be seen as simply describing the services emanating from ALLIED.

Although we have discussed at some length our reasons for finding ALLIED to be the dominant term in applicant's and the registrants' marks, we wish to make clear that we have compared the marks in their entirety, and not simply the word ALLIED alone. However, it is well established that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, as long as the ultimate conclusion rests on a consideration of the marks in their entirety, there is nothing improper in stating that, for rational reasons, more or less weight has been

Ser. No. 74/304,743

given to a particular feature of a mark. See **In re In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Accordingly, although applicant details specific differences in the appearances, pronunciations and connotations between its mark and the cited registrations, applicant's mark and each of the cited marks convey similar commercial impressions, such that consumers, even if they were to note the specific differences, would still be likely to think that applicant's mark was a variation of the cited marks, rather than indicating a separate source of origin. We would also point out that, under actual marketing conditions, consumers do not have the luxury of making side-by-side comparisons between marks, and instead must rely on hazy past recollections. See **Dassler KG v. Roller Derby Skate Corp.**, 206 USPQ 255 (TTAB 1980). Thus, even though we acknowledge that the purchase of applicant's and the registrant's services is not done on impulse, consumers, even sophisticated ones, are likely to be confused as to the source of the various services because of the similarity of the marks.

Applicant has argued that the only element common to the marks, the word ALLIED, is weak. We see nothing about the dictionary definitions of "allied" quoted by applicant-

- "joined, connected; joined in alliance by compact or treaty; related esp. by common properties, characteristics or ancestry"--which indicates that this word is even suggestive of underwriting insurance, administering group health insurance, or administering employee benefit plans and retirement plans. Applicant has also made of record a listing of 158 company names containing the word "Allied," along with the addresses of these companies. Applicant asserts that this is a summary of website "hits" retrieved through a search of the Internet. This listing is of very little probative value in terms of showing that the public is familiar with third parties having services similar to applicant's or to the two registrant's. For example, it is not clear from the summary whether each listing represents a separate company, or are branch offices of a single company. In this connection, we note that there are 18 listings for Allied Auto Insurance at various locations in South Florida. Nor can we determine from the summary whether these listings are all for third parties, or whether some of the listings are for the registrants or applicant. For example, there is a listing for The Allied Companies, Inc. with applicant's address in Michigan, which we presume refers to applicant itself. Another listing for Allied Group Insurance, with an address in Royal Oak,

Michigan, may refer to applicant's Allied Group Insurance Services, Inc. Similarly, the numerous references to Allied Insurance or Allied Insurance, Inc. may well be listings for the owner of the ALLIED INSURANCE COMPANY registration. Simply put, the summary submitted by applicant of its Internet search is not sufficient to prove that the word ALLIED is weak, such that the consuming public would be able to distinguish applicant's mark from the marks of the cited registrations based on the additional elements in applicant's mark.⁷

The only indication of any weakness of the term ALLIED is the fact that both of the registrants have adopted the term as part of their marks. However, the fact that two companies have used this word is an insufficient basis for us to conclude that it is a weak term in the insurance and financial field, and that the owners of these registrations are entitled to a limited scope of protection.

Applicant also points to the fact that Allied National's registrations were registered despite the existence of the registration for ALLIED INSURANCE COMPANY in support of its claim that there is no likelihood of

⁷ As noted previously, the listing of third-party registrations submitted by applicant with its brief was not properly made of record and has not been considered.

confusion between applicant's mark and the cited registrations. However, the files of these registrations were not properly made of record, and therefore we do not know the basis for the Examining Attorney's conclusion that confusion between the Allied National marks and ALLIED INSURANCE COMPANY was not likely. Certainly there can be evidentiary factors, such as a consent agreement, which may persuade an Examining Attorney that one mark is registrable despite the existing registration of a similar mark, when another mark is found to be unregistrable.

Finally, applicant argues that it is unaware of any instances of actual confusion and that this indicates that confusion is not likely. Applicant asserts use of its mark since 1985, but has acknowledged that such use is primarily in the Southeast Michigan area. We cannot conclude based on the evidence of record that there has been an opportunity for confusion to have occurred, such that we can conclude from the lack of such evidence that confusion is not likely. First, we have no information from the registrants about whether they have encountered any actual confusion. Second, and more importantly, we have no information about the extent of the registrants' use, and very little information about the amount of applicant's use. Even from the information we do have, however, it

Ser. No. 74/304,743

appears that applicant's services have been rendered in a relatively limited geographic area, and this could well explain why applicant is not aware of any actual confusion.

Decision: The refusal to register on the basis of the five cited registrations is affirmed.

E. J. Seeherman

C. E. Walters

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board